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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,381	10/28/2003	Albert K. Chin	80121-08565	8269
758	7590	07/17/2007		
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	
			MAIL DATE	DELIVERY MODE
			07/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/696,381	CHIN, ALBERT K.	
	Examiner	Art Unit	
	Philip R. Smith	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/15/07</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Terminal Disclaimer**

- [01] The terminal disclaimer filed on 5/1/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date has been reviewed and is accepted. The terminal disclaimer has been recorded.

**Claim Rejections - 35 USC § 102**

- [02] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- [03] Claims 1-2,4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Gibson (702,789).
- [04] With regard to claim 1: Gibson discloses an apparatus for performing a surgical procedure comprising:
- [04a] an inner cannula having an elongated body ("rod D," 1/50) and a tip positioned at a distal end of the elongated body ("pear-shaped piston or plunger D<sup>2</sup>," 2/65); and
- [04b] an outer expandable sheath ("tube A," 1/28) disposed about the inner cannula and configured to expand in an outward direction responsive to the tip of the inner cannula passing through the sheath (2/71-89).
- [05] With regard to claim 2: the tip disclosed by Gibson ("D<sup>2</sup>," as noted above) has an outer dimension greater than an inner dimension of the sheath and includes a proximal tapered end ("rod D," as noted above) for facilitating passing of the tip through the sheath.

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- [06] With regard to claim 4: Gibson further discloses that the outer expandable sheath further comprises: a first shell and a second shell ("segmental bars e'," 2/60-70) adjacently aligned along longitudinal edges thereof, and a resilient connector ("thin soft rubber sheath C," 2/81) attached between the first and second shells for resiliently urging the longitudinal edges of the shells together.
- [07] With regard to claim 5: Gibson further discloses that the outer expandable sheath further comprises a retainer ("nut E," 2/74) disposed near the proximal end of the shells for retaining the shells against relative longitudinal movement during passage of the inner cannula through the outer expandable sheath.
- [08] With regard to claim 6: Gibson discloses that the inner cannula and outer expandable sheath are separable to allow the outer expandable sheath to remain in place at a surgical site as the inner cannula is withdrawn. It does not appear that inner cannula disclosed by Gibson may be completely withdrawn from the outer expandable sheath disclosed by Gibson; however, the inner cannula may be at least partially withdrawn while the expandable sheath remains in place, thus anticipating the claim.
- [09] With regard to claim 7: the resilient connector disclosed by Gibson resiliently urges a distal end of the first shell toward a distal end of the second shell (a point indicated by "a<sup>2</sup>" in the figures) to form an inner dimension at the distal end of the outer expandable sheath smaller than the outer dimension of the tip in the absence of an outwardly expansive force applied to the distal end of the outer expandable sheath in response to the tip passing through the distal ends of the shells.
- [10] With regard to claim 8: Gibson further discloses that the outer expandable sheath further comprises: a second resilient connector ("nut E," 2/74) disposed to resiliently urge a proximal end of the first shell toward a proximal end of the second shell to form an inner dimension at the proximal end of

the outer expandable sheath smaller than the outer dimension of the tip in the absence of an outwardly expansive force applied to the proximal end of the outer expandable sheath in response to the tip passing through the proximal ends of the shells.

- [11] With regard to claim 9: Gibson discloses that at least one of the shells of the outer expandable sheath is flexible to bend in response to passing of the tip through the outer expandable sheath (2/75, with reference to Figure 2).
- [12] With regard to claim 10: the tip disclosed by Gibson further comprises a distal tapered end, a proximal tapered end, and an enlarged intermediate portion (e.g., "pear-shaped," as noted above) having an outer dimension greater than an inner dimension of the sheath for exerting lateral expansion force against the outer expandable sheath responsive to passage of the tip through the outer expandable sheath.

**Claim Rejections - 35 USC § 103**

- [13] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [14] Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson in view of Davis (6,030,406)
- [15] Gibson discloses a cannula having a tip, as noted above.

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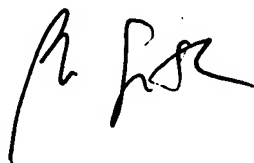

- [16] Gibson does not disclose that the tip is transparent and the apparatus further comprises an endoscope disposed within the cannula for providing endoscopic visualization of the surgical procedure through the transparent tip.
- [17] Davis discloses a cannula having a "transparent tip 13" (4/64-5/18) which "facilitates visualization of the tissue being dissected" (14/57), in addition to an endoscope, for visualization (5/1).
- [18] At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the cannula disclosed by Gibson have a transparent tip as taught by Davis. A skilled artisan would be motivated to provide a transparent tip in order to facilitate visualization of the subject being dissected, as taught by Davis.

#### **Conclusion**

- [19] A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
- [20] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [21] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.

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[22] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'A. R. R.' or similar, located on the left side of the page.A handwritten signature in black ink, appearing to be 'Linda C. M. Dvorak', located on the right side of the page.

**LINDA C. M. DVORAK**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 3700**